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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/541,845	04/03/2000	Jodi A. Dalvey	946.008US1	4258

7590

04/16/2003

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EXAMINER
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HESS, BRUCE H

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 04/16/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-9

# Office Action Summary

Application No.

09/541,845

Applicant(s)

Dalvey et al.

Examiner

Bruce Hess

Group Art Unit

1774

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 1-21-03 (Election)
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above claim(s) 17-20 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-16 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2 and 3
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

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1. The restriction requirement of Paper No. 6 is adhered to and made final for the reasons of record.

~~X~~ Claims 1-16 are rejected under 35 USC 112 (second paragraph) for the reasons set forth below:

- a. Claims 1-16 fail to recite an underlying support for the image transfer sheet;
- b. What and where is the "indicia" (see the last word in claim 1) in claims 1-6?; and
- c. In claim 6, how can an "indicia" be encapsulated?

3. The following claims are rejected under 35 USC 102 (b) as being anticipated.

- ~~X~~ Claims ~~X~~ ~~X~~ (7, 9 and 11) <sup>dropped because of new matter</sup> over Shimomine et al (USP 5,434,598);
- ~~X~~ Claims ~~X~~ ~~X~~ (7, 9 and 16) <sup>9 10 11 12 13 14 15 16</sup> over Kiyoshi (JP 01037233);
- (c) Claims 1, 2, 5, 7 and 9-16 over either of the Sato et al patents (EP 0 881 092 or EP 0 933 225); and

~~X~~ Claims ~~X~~ (7 and 8) <sup>7 8</sup> over Mitsuhide et al (EP 22 95973).

4. The following claims are rejected under 35 USC 103 as being obvious over.

- ~~X~~ Shimomine et al (claims ~~X~~ ~~X~~ 5 (7, 9 and 11) <sup>X 5</sup>);
- ~~X~~ Kiyoshi (claims ~~X~~ ~~X~~ 5 (7, 9 and 16) <sup>X 5</sup>);
- (c) Sato et al '092 or Sato et al '225 (claims 1, 2, 5-7 and 9-16) <sup>1-3 4 8</sup>; and
- ~~X~~ Mitsuhide et al (claims 1-9, 11-14 and 16) <sup>1-9</sup>.

~~X~~ ~~X~~ ~~X~~ ~~X~~ ~~X~~ ~~X~~

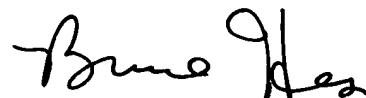
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All of these patents teach image transfer sheets comprising a support, a release layer and a polymer layer. The patents to Shimomine et al (see column 2, lines 48, 49 and 51-54; column 4, lines 31-33 and column 5, lines 4-6), Kiyoshi, Sato et al '092 (see page 3, lines 14-16; page 4, line 58; and page 6, line 31) and Sato et al '225 (see page 5, lines 34, 35 and 41; page 6, line 47) teach the advantages of employing titanium oxide in the polymer layer while the patent to Mitsuhide et al teach the advantages of employing titanium oxide in the release layer. The patents to Sato et al and Mitsuhide et al teach that the colored substrates can be fabric. The polymers employed by the prior art can be polypropylene (Sato et al '092 and '225), polyester and/or polyamide (Shimomine et al, Sato et al '092, Sato et al '225 and Mitsuhide et al) or EVA (Kiyoshi and Mitsuhide et al). Finally, the experimental modification of the prior art in order to ascertain optimum operating conditions (e.g., select the color of the substrate) fails to render applicants' claims patentable in the absence of unexpected results.

Any inquiry concerning this communication should be directed to Bruce Hess at telephone number (703) 308-2402.

B. Hess/dh

April 15, 2003



BRUCE H. HESS  
PRIMARY EXAMINER